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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,655	01/05/2006	J. Christopher Anderson	54-000410US	3991
22798 7590 04/09/2008 QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C. P O BOX 458 ALAMEDA, CA 94501				
EXAMINER GEBREYESUS, KAGNEW H				
ART UNIT 1656		PAPER NUMBER		
MAIL DATE 04/09/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,655

Applicant(s)

ANDERSON ET AL.

Examiner

KAGNEW H. GEBREYESUS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16, drawn to a composition comprising an orthogonal leucyl-tRNA (leucyl- p comprising a CU(X)_nXXXAA sequence, and comprises at least about a 25% suppression activity in presence of a cognate synthetase in response to a selector codon as compared to a control lacking the selector codon.

Group II, claim(s) 17-26, drawn to a cell comprising a translation system where the translation system comprises an orthogonal leucyl-tRNA (leucyl- OtRNA) comprising a CU(X)_nXXXAA sequence, and an orthogonal leucyl aminoacyl tRNA synthetase that preferentially amino acylates said OtRNA^{leu}.

The inventions in Group I and Group II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2.

The technical feature first mentioned in Group 1 is a composition comprising an O-tRNA^{leu} comprising a CU(X)_nXXXAA sequence, and comprises at least a 25%

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suppression activity in the presence of a cognate synthetase in response to a selector codon as compared to a control lacking a selector codon. However, Thorbjarnardottir et al (Leucine tRNA family of *E. coli*: Nucleotide sequence of *supP*(AM) Suppressor Gene, Journal of Bacteriology, Jan. 1985, p. 219-222) teach the cloning and sequencing of a leucyl tRNA from *E. coli* that suppresses an amber codon including the structural limitation of claim 1, i.e., an anticodon sequence of CU(X)_n XXXAA.

Thorbjarnardottir et al on page 220, fig. 1 show a tRNA^{leu} with an anticodon sequence CU(X)₄₂ CTAAA (see positions 61-105 of sequence) wherein said sequence comprises the suppressor codon. No correlation between a specific structure and the function i.e. 25% suppression activity is provided in Applicants claim. Thus technical feature linking the inventions in Group I and group II is not a special technical feature as it does not contribute over the prior art.

Requirement Applicable to all Groups

Furthermore, the presence of multiple polynucleotide sequences, each with a different SEQ ID NO: allows for a variety of patentably distinct products. Depending on the sequence of each polynucleotide, the characteristics of the resulting molecule will vary in regards to structure and function. Each one of the mentioned polynucleotides is capable of hybridizing to different probes and is capable of encoding a characteristically different peptide in regards to structure and activity. Therefore these polynucleotides are patentably distinct absent factual evidence to the contrary. Rejoinder of all or a specified subset of the sequences is possible if Applicants provide a single and specific representative subsequence found in all or a specified subset of the sequences for

search, and state that all or a specified subset of the sequences are not patentably distinct. Applicants are informed that if their specified sequence is found that all or a specified subset of sequences are obvious over that prior art sequence.

Applicant is required under 35 U.S.C. 121 to elect a single SEQ ID NO: for prosecution on the merits. The applicant should be aware that selection of a single SEQ ID NO: represents a response to a restriction requirement of a patentably distinct product, not an election of species.

The products listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the products lack the same or corresponding special technical features for the following reasons: Each sequence has a patentably distinct structure that functions with a specific corresponding OtRNA synthetase.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MONDESI whose telephone number is (571)272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nashed Nashaat can be reached on (571)272-0934. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert B Mondesi/
Primary Examiner
Art Unit 1652
March 31, 2008

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